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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,734	09/23/2003	John J. Toben	6006-141-1	2477

7590 03/14/2006

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EXAMINER

GARCIA, ERNESTO

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/668,734

Applicant(s)

TOBEN ET AL.

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2-11 and 17-19 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 21 is/are allowed.
- 6) ☒ Claim(s) 1 and 12-16 is/are rejected.
- 7) ☒ Claim(s) 12-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Election of Species*

Claims 2-11 and 17-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/23/2005.

### *Drawings*

The drawings were received on 12/23/2005. These drawings are acceptable; however, the changes to the claims raise new objections.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "108" and "116" have both been used to designate the same duct wall in Figure 4.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the ductwork" (claim

1) and "an interior of said ductwork (claim 12, lines 7-8) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. According to the drawings, the figures only show two duct walls 108,122 and a seam 100 between the duct walls 108,122.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The disclosure is objected to because reference character "206" on page 9, line 1, should be --220--. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "a first fold which bent at a break point" recited in claim 12, line 6-7 lacks proper antecedent basis.

***Claim Rejections - 35 USC § 112***

Claims 1 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 12, there is an inconsistency between the language in the preamble and a certain portion in the body of the claim, thereby making the scope of the claims unclear. The preamble clearly indicated that the seam is "for ductwork". However, the body of the claim positively recites "the ductwork", e.g., "said seam having a male end portion integrally formed with said ductwork" (lines 1-2), "a female end portion integrally formed with said ductwork" (lines 4-5), and "said female groove lies

adjacent an outer surface of said ductwork" (line 11), which indicates that the claims are being drawn to a combination of the "seam" and the "ductwork". Accordingly, is the combination or subcombination being claimed? Appropriate correction, clarification, or both is required. For purposes of examination, the examiner has considered the seam alone.

Regarding claim 12, the limitation "said duct wall" in lines 7 and 10 lacks proper antecedent basis. According to the changes made to claim 12, "a duct wall" is no longer recited to provide proper antecedent basis.

Regarding claims 13-16, these claims depend from claim 12 and therefore are indefinite.

### ***Claim Rejections - 35 USC § 102***

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Van Huffel, 2,086,143 (see marked-up attachment provided in the last Office action).

Regarding claim 1, as best understood, Van Huffel discloses, in Figure 5, a seam comprising a male end portion **A9** and a female end portion **A1**. The male end portion **A9** is integrally formed with a ductwork **3**. The female end portion **A1** is integrally formed with the ductwork **3**. The female end portion **A1** includes a first fold **A4** and a

second fold **A5**. The first fold **A4** and the second fold **A5** define a female groove **A6**. A distal end **A7** of the second fold **A5** is bent transverse to the female groove **A6** prior to the male end portion **A9** being inserted into the female groove **A6**. The female groove **A6** lies adjacent an outer surface of the ductwork **3** (see Figure 7).

***Allowable Subject Matter***

Claims 20 and 21 were previously allowed.

Claims 12-16, as best understood, would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 12, the prior art of record does not disclose or suggest a seam, in combination with a duct wall, comprising a third fold beginning substantially adjacent to a break point and extending substantially parallel to the duct wall; the European patent, EP-71,586, teaches the third fold extending substantially coaxial to the duct wall and there is no motivation absent applicant's own disclosure to extend the third fold substantially parallel to the duct wall as the third fold creates a groove with a fourth fold; and,

regarding claims 13-16, these claims depend from claim 12.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 12-16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. In particular, the new limitation "formed with said ductwork" in claims 1 and 12, lines 2 and 5, and "wherein said female groove lies adjacent an outer surface of said ductwork" in claim 1, line 11, necessitated the new grounds of rejections. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Caldwell, 354,390, shows a similar seam.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-70837083. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

E.G.

March 6, 2006

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is written in a cursive, flowing style.

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

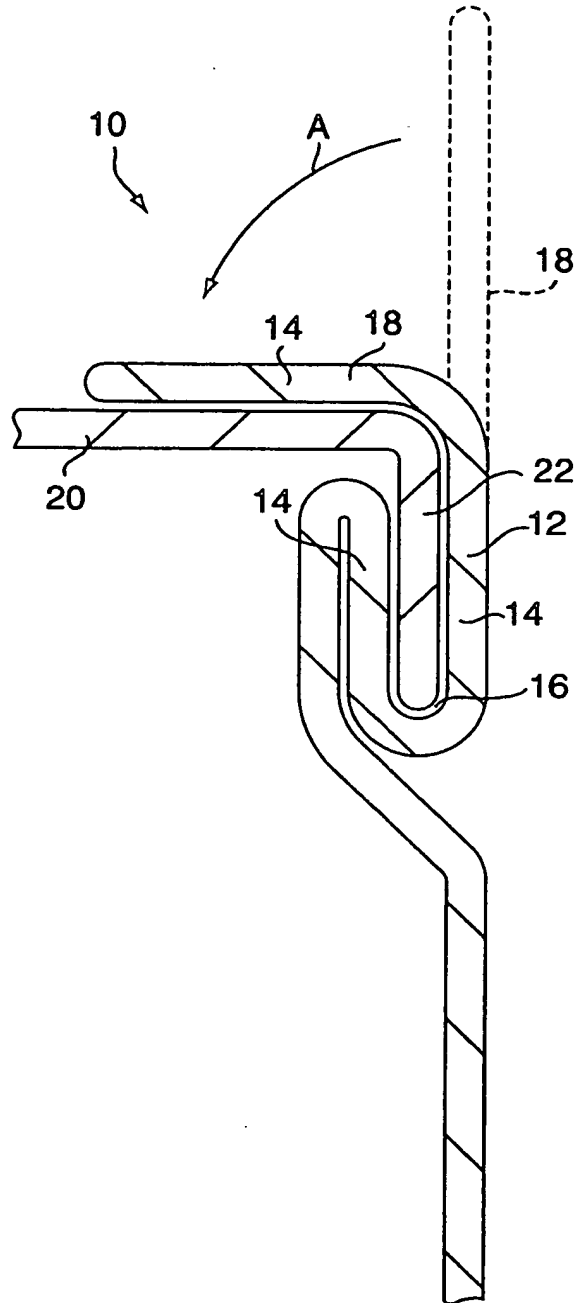


FIG. 1  
Prior Art

Accepted  
EL, 2/24/06

2/4

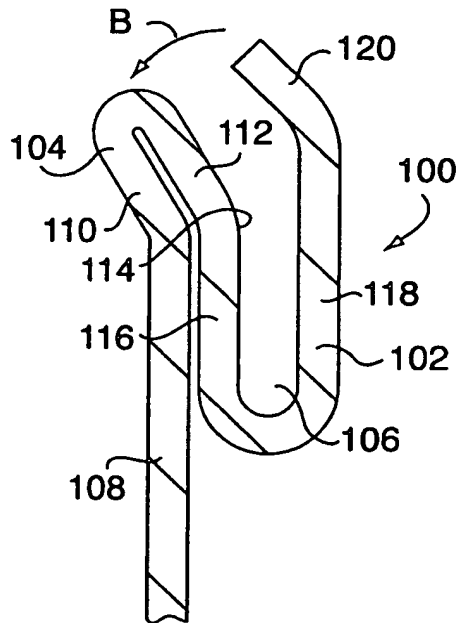


FIG. 2

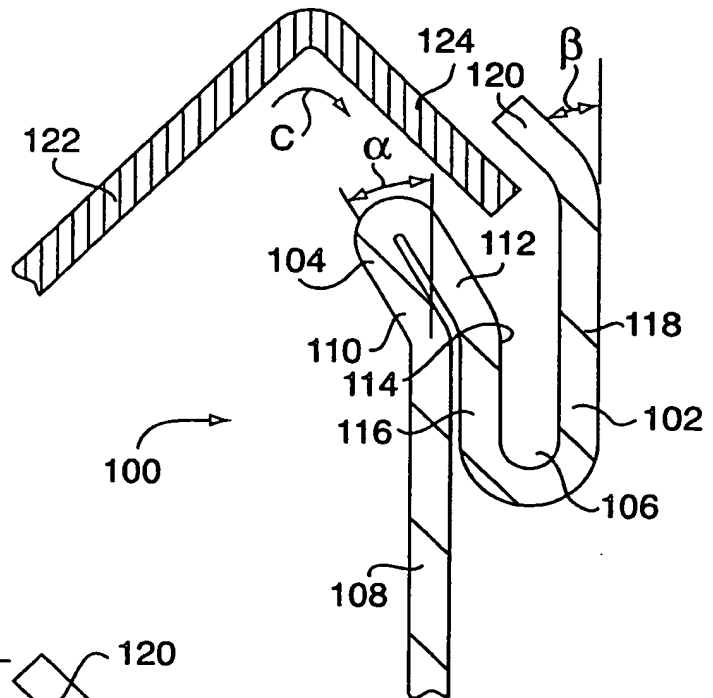


FIG. 3

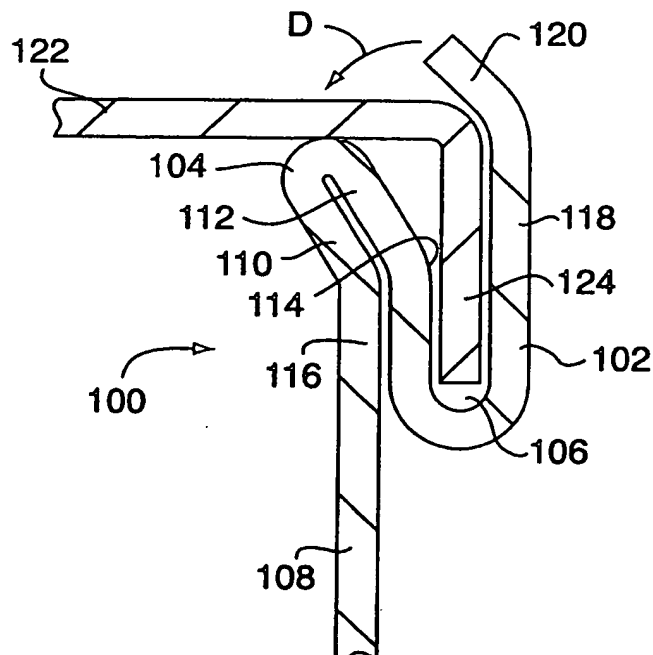


FIG. 4

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 El. 2/24/06



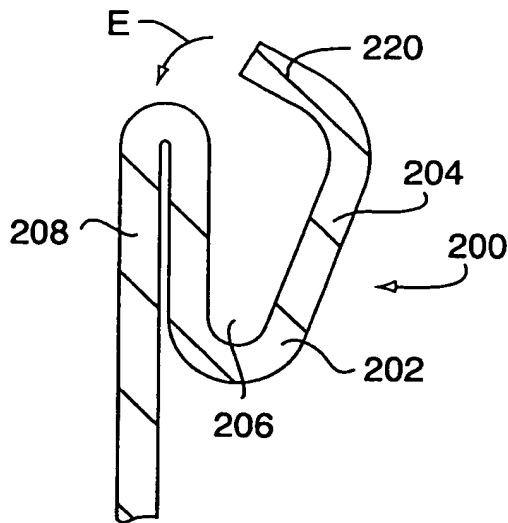


FIG. 5

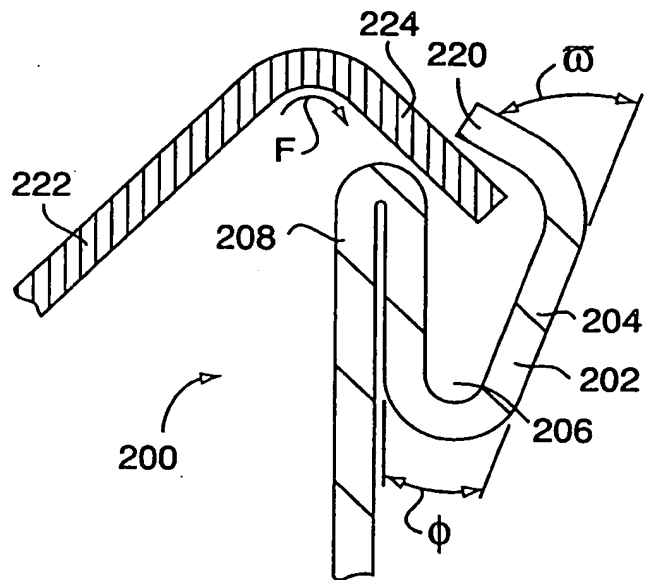


FIG. 6

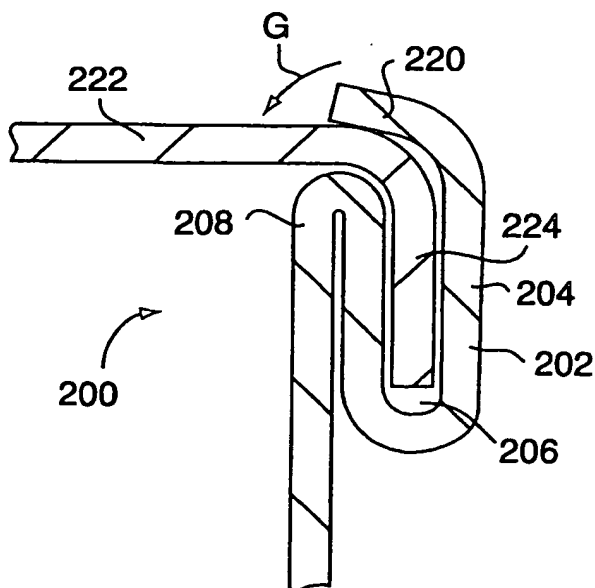


FIG. 7

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 2/24/06